

REMARKS

In the application claims 1-26 remain pending.

Pending claims 1 and 13 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Chung (U.S. Published Application No. 2002/0077155) as modified by Soini (U.S. Patent No. 6,611,693).

Pending claims 2-4 and 14-16 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Chang as modified by Soini as further modified by Dudek (U.S. Patent No. 5,523,800).

Pending claims 5-12 and 17-26 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Chang as modified by Soini as further modified by Mulla (U.S. Published Application No. 2002/0162891).

The reconsideration of the rejections of the claims is respectfully requested. In particular, it is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that a combination of references disclose, either expressly or inherently, each and every element set forth in the claims, considering the claims “as a whole.” The requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, *with no knowledge of the claimed invention*, would have selected the various parts from the references

and combined them in the claimed manner. In other words, the test of whether it would have been obvious to select specific teachings and combine them must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.

Turning first to Chung, it is respectfully submitted that Chung simply fails to disclose, teach, or suggest all of the claimed elements accepting the portable electronic device being a remote control. In this regard, while the rejection of the claims has alleged that Chung discloses a method or computer-readable media that invokes a diagnostic routine which measures a size of a writeable memory and which then presents an indication of the size of the writeable memory as measured by the diagnostic routine in paragraphs 0033-0035 and Figs. 4 and 5, it is respectfully noted that none of these claimed elements are disclosed, taught, suggested, or even alluded to within Chung. In this regard, as seen below, cited to paragraphs 0033-0035 of Chung disclose nothing more than a method for placing information into available memory locations within a phone book stored in a memory of a mobile phone:

[0033] The same memory space assigning method described above holds true for other memory fields. Hence, according to the preferred embodiment, it is not necessary to fill in an assigned memory area, especially when desired information is not available.

[0034] Fig. 4 is a structural diagram illustrating the saved memory area according to the memory saving method depicted in Fig. 3. The shaded portion in Fig. 4 indicates the memory areas, which had been left unused in the related art memory assignment structure of Fig. 2 due to unavailability of data, but which are being efficiently used according to the preferred embodiment of the present invention. Thus, previously unoccupied memory area are converted into usable memory for other data. All vacant memory areas created due to lack of necessary information for inputting to each field can therefore be used.

[0035] Fig. 5 is a flow chart which illustrates a method of how to use a memory area more efficiently according to the preferred embodiment. As shown in Fig. 5, a user first inputs a name of an intended person for storage (step 41). When a name is entered, the search for the prerecorded same name is preferably

automatically conducted. A user, however, may also manually check to determine whether there is an index corresponding to the name of the person being entered (step 42).

Thus, from the foregoing, it is evident that the cited to passages from Chung, as well as Chung in its entirety, fails to have any teachings directed to measuring memory size (let alone using a diagnostic routine) or then presenting an indication of the size of the memory so measured. As further evidence of this fact, it is noted *that the words "measure" or "size" never even appear within the disclosure of Chung*. Accordingly, since Chung in no way can be read as disclosing, teaching, or suggesting "a method for presenting a size of a writeable memory within a portable electronic device for a remote communication comprising invoking a diagnostic routine within the portable electronic device for a remote communication which measures a size of the writeable memory and using the portable electronic device for a remote communication to present an indication of the size of the writeable memory as measured by the diagnostic routine" as asserted and relied upon in the rejection of the claims, it is submitted that a *prima facie* case of obviousness has not been established and the rejection of the claims must be withdrawn.

As concerns Soini, it is respectfully submitted that the mere fact that Soini may disclose a mobile device that may function as a remote control and which may further have its flash memory expanded with an add-on module (Col. 6, lines 61+) simply cannot be said to disclose, teach, or suggest modifying Chung to include that which is missing from Chung in the first instance, namely, a method for presenting a size of a writeable memory within a portable electronic device for a remote communication comprising invoking a diagnostic routine within the portable electronic device for a remote communication which measures a size of the writeable memory and using the portable electronic device for a remote communication to present an indication of the size of the writeable memory as measured by the diagnostic routine.

Accordingly, the combination of Chung and Soini cannot be said to have the disclosure required to support a *prima facie* case of obviousness and the rejection must be withdrawn.

Turning now to Dudek, while Dudek suggests on Page 16, lines 51+ the desirability of using an LED to display battery power status or to indicate operation termination, nothing from Dudek discloses, teaches, or suggest blinking an LED to convey any sort of numerical information or information corresponding to anything measured. Furthermore, nothing from Dudek discloses, teaches, or suggest the desirability of using blinks to indicate digits - which fact has been acknowledged in the Office Action. Accordingly, it is respectfully submitted that nothing from Dudek can be said to demonstrate that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have found it desirable to use blinks of an LED to convey information corresponding to a numerical value, let alone to indicate digits of a numerical value and, as such, any conclusion that Dudek somehow suggests modifying Chung to arrive at the invention claimed could only have been arrived at by impermissibly using the Applicant's disclosure as a guide to first modify how the LED of Dudek is used and to then combine the Dudek LED, so modified using the Applicant's teachings, with Chung. For at least this reason it is submitted that the rejections of the claims that rely upon Dudek clearly reflect the impermissible use of "hindsight reasoning" and, as such, the rejections of the claims based upon the combination of Chung, Soini, and Dudek must be withdrawn.

Turning finally to Mulla, while Mulla may disclose emitting a sound, the sound is emitted from the Mulla pen only when it is determined that there is little memory space left. However, Mulla fails to disclose, teach, or suggest informing the user via the emitted sound how much memory space is left (or overall memory size). Specifically, nothing from Mulla discloses, teaches, or suggests indicating (by sound or otherwise) anything measured or using one of a

plurality of sounds to anything measured. Accordingly, nothing from Mulla can be said to suggest modifying Chung, alone or in combination with the other cited references, to arrive at the exact invention set forth in the claims and the rejection of claims 5-12 and 17-26 under 35 U.S.C. § 103 must also be withdrawn.

Conclusion

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested.

Should it be determined that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

The Commissioner is authorized to charge any fee deficiency or credit overpayment to deposit account 50-2428 in the name of Greenberg Traurig.

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